REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 4, 2007 ("Office Action"). Claims 1-8, 10, 11, 26 and 27 are pending in the application. The Examiner rejects Claims 1-8, 10, 11, 26 and 27. Applicant respectfully requests reconsideration and allowance of all pending claims.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejects Claims 1-8, 10, 11, 26 and 27 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,177,964 B1 issued to Birleson, et al. (*"Birleson"*). Applicant respectfully requests reconsideration and allowance of all pending claims.

At the outset, Applicant respectfully submits that the Examiner has failed to provide a proper rejection of all claims. With respect to Claim 1, the Examiner appears to equate the "filter 101" of *Birleson* with the "filter" of Claim 1. Moreover, the Examiner notes that "regarding the dissipating the undesired channels from being sent to the transmitter is a function of placing the filter on the tuner chip – which is stated in the applicant's specification." (Office Action, p. 2). However, the Examiner fails to identify any portion of *Birleson* that teaches, suggests, or discloses the formation of "filter 101" on an "integrated circuit." The Examiner assumes that to be the case because "filter 101" is described with reference to tuner 10. However, the Examiner does not identify any portion of *Birleson* that teaches "filter 101" being a part of an "integrated circuit". Thus, the Examiner's rejection is improper.

Next, the Examiner acknowledges that *Birleson* "discloses that filter 101 ... is used to retrieve all TV signals." (Office Action, p. 2). *Birleson* teaches that in the U.S., "television signals are generally transmitted in a band from 55MHz to 806 MHz." (*Birleson*, col. 10, ll. 10-12). It is clear from FIGURE 1 of *Birleson* that filter 101 receives signals in the range of 55-806MHz, and it is equally clear from the text of *Birleson* that filter 101 outputs signals in the range of 55-806 MHz too. Indeed, *Birleson* states that, "[a]s distinguished from the prior art, filter 10 is not a narrow band pass tracking filter which attenuates most television channels from the received signal. Instead, **filter 101 passes all channels in the television band**." (*Birleson*, col. 7, ll. 58-61; emphasis added). Thus, *Birleson* teaches receiving signals from 55-806 MHz and teaches passing signals from 55-806MHz. In this regard, *Birleson* explicitly ***teaches away*** from "a filter operable to receive an input signal comprising

a first number of channels and further operable to communicate an intermediate output signal comprising a second number of channels less than the first number of channels," as recited, in part, in Claim 1. Notwithstanding this clear teach away of claimed subject matter in *Birleson*, the Examiner inexplicably concludes that "by simply replacing the filter 101 of *Birleson* with the conventional filter, would render obvious the pending claim." In doing so, the Examiner openly ignores the portion of *Birleson* that clearly teaches away from receiving "a first number of channels" and communicating "a second number of channels less than the first number of channels." This is impermissible. The Examiner is reminded that "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied,* 469 U.S. 851 (1984). (M.P.E.P. § 2141.02). Moreover, although the Supreme Court recently denounced the rigid application of the "TSM" test in *KSR v. Teleflex*, 127 S.Ct. 1727 (2007), the Federal Circuit has subsequently found a patent not obvious where the relevant prior art taught away from the claimed invention. *Takeda Chemical v. Alphapharm*, 2007 WL 1839698 (Fed. Cir. 2007).

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1.

With respect to Claim 2, the Examiner states that "the concept of filtering/tuning down the number of channels received has been evidenced above." (Office Action, p. 3). Applicant respectfully submits that this is incorrect. As described above, "filter 101" of *Birleson* passes "**all channels** in the television band" and, therefore, the concept of "filtering/tuning down the number of channels" is expressly taught away by *Birleson* with respect to "filter 101." For at least this reason, and because Claim 2 depends from Claim 1 shown above to be allowable, Applicant respectfully requests reconsideration and allowance of Claim 2.

The Examiner makes similar conclusory and improper rejections of the remaining dependent and independent claims. Applicant respectfully traverses all the rejections made in this Office Action. For at least the reasons set forth above with respect to Claims 1 and 2, Applicant respectfully requests reconsideration and allowance of Claims 2-8, 10, 11, 26, and 27.

CONCLUSION

If there are matters that can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to call the undersigned attorney at (214) 953-6581 at the Examiner's convenience.

Applicant believes that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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